

Remarks

The present application includes claims 1, 3-9, and 11-25. Claims 1, 3-9, and 11-25 have been rejected by the Examiner. By this Response, claims 1, 9, 16, 17, 18, 19, and 22 have been amended, and claim 7 has been canceled.

Claims 1, 9, 16, 17, 18, 19, and 22 have been amended to recite that a flashing representation of at least one composite symbol is created by placing a flashing symbol animation on top of the overlying part of the background scene to provide a flashing composite symbol. This limitation was recited in dependent claim 7, which has now been canceled. As such, the Applicant submits that no new matter is added through this amendment, and no new search should be required. The Applicant respectfully submits that the pending claims of the present application should be allowable over the cited art of record.

Claims 1, 3, 6-9, 12, 13, and 16-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aristocrat Leisure Industries (WO 99/64997)(hereafter ALI) in view of Suzuki (6,213,875).

Applicant respectfully traverses the Examiner's rejection for at least the following reasons.

As previously discussed, Suzuki relates to a mini-display Pachinko machine. In Suzuki, the background scene is not visible for the duration of the game and is not visible during the spinning of the reels, as recited in the claims of the present application. Rather, in Suzuki, the background with special symbols, as shown in Figures 24 and 25 is

displayed only at a final, reached state to interest the player. See, e.g., col. 17, line 53 – col. 18, line 6.

The Examiner states that the ALI reference does not explicitly teach “the limitations of the composite symbols overlies the background scene (claims 1, 9, 12, 13, 16, 17, 18, 19, 22); rendering at least the carrier portions of at least certain of the composite symbols transparent to enable the background scene to be viewed through the carrier portions, wherein the composite symbols arranged end-to-end such that the carrier portions of the at least certain composite symbols define in combination a transparent reel strip portion through which the underlying background scene is viewable, and wherein the background scene spans the video representation of the spinning reels and does not form part of any said combinations of composite symbols (claims 1, 9, 16, 17, 18, 19, 22); and wherein at least one said winning combination comprises at least one composite symbol having a carrier portion that has been rendered transparent (claims 1, 9, 12, 16, 17, 18, 19-22).”

Additionally, as amended, claim 1 recites that if a winning combination occurs in a game play of the spinning reel game, following the spinning up of combinations on the reels, the composite symbols that formed the winning combination are indicated. At least one winning combination includes or comprises at least one composite symbol having a carrier portion that has been rendered transparent. A flashing representation of the at least one composite symbol is created by placing a flashing symbol animation on top of the overlying part of the background scene to provide a flashing composite symbol. Such a limitation is neither taught nor suggest by Suzuki or a combination of Suzuki and the ALI reference. As noted by the Examiner, the ALI reference does not teach composite

symbols overlying the background scene, and rendering the carrier portions transparent to view the background scene through the carrier portions, etc., wherein the winning combination includes at least one composite symbol having a carrier portion that has been rendered transparent. Suzuki also fails to disclose any sort of flashing symbol animation. Additionally, the Applicant submits that such a representation in the context of the gaming systems and methods recited in the presently pending claims is neither inherent nor notoriously well known in the gaming arts.

It is well established that an examiner is not permitted to use an improper hindsight reconstruction of the claimed invention in rejecting the claims. Use of hindsight analysis has been specifically condemned by the Federal Circuit:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification ... Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This Court had previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

In Re John Fritch, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992). See also *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1135, 1143 n.5, 229 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986); MPEP 2141.

The limitations recited in the pending claims go well beyond use of a particular graphic. The claims recite a particular configuration to execute a game and interest a player. The Applicant respectfully submits that claims 1, 3-6, 8-9, and 11-25 represent novel, useful and non-obvious improvements over the prior art of record and should be

allowable. As discussed further below, if the Examiner is asserting that the particular system and methods claimed in the present application are either inherent or well known (i.e., taking official notice), then the Examiner is asked to provide further evidence to which the Applicant can respond. As it now stands, such evidence appears to be lacking.

If the Examiner's assertions are based on the personal knowledge of the Examiner, then under MPEP § 2144.03(C) and 37 C.F.R. § 1.104(d)(2), the Examiner's assertions must be supported by an affidavit from the Examiner. According to MPEP § 2144.03(A), Official Notice, without supporting references, should only be asserted when the subjects asserted to be common knowledge are "capable of instant and unquestionable demonstration as being well-known." That is, the subjects asserted must be of "notorious character" under MPEP § 2144.03(A).

However, the Applicant respectfully submits that the subject matter of the Examiner's assertion of Official Notice is not well-known in the art as evidenced by the searched and cited prior art. The Applicant respectfully submits that the Examiner has performed "a thorough search of the prior art," as part of the Examiner's obligation in examining the present application under MPEP § 904.02. Additionally, the Applicant respectfully submits that the Examiner's searched and cited references found during the Examiner's thorough and detailed search of the prior art are indicative of the knowledge commonly held in the art. However, in the Examiner's thorough and detailed search of the relevant prior art, none of the prior art taught or suggested the subject matter of the Examiner's assertion of Official Notice. That is, the Examiner's thorough and detailed search of the prior art has failed to yield any mention of the teachings that the Examiner is asserting as widely known in the art. The Applicant respectfully submits that if the

subject matter of the Examiner's assertion of Official Notice had been of "notorious character" and "capable of instant and unquestionable demonstration as being well-known" under MPEP § 2144.03(A), then the subject matter would have appeared to the Examiner during the Examiner's thorough and detailed search of the prior art.

If the Examiner had found any teaching of relevant subject matter, the Examiner would have been obligated to list the references teaching the relevant subject matter and make a rejection. Consequently, the Applicant respectfully submits that the prior art does not teach the subject matter of the Examiner's assertion of Official Notice and respectfully traverses the Examiner's assertion of Official Notice.

As stated above, the Applicant respectfully traverses the Examiner's assertions of Official Notice and submits that the subject matter is not of such "notorious character" that it is "capable of instant and unquestionable demonstration as being well-known." Under MPEP 2144.03, the Examiner is now obligated to provide a reference(s) in support of the assertion of Official Notice if the Examiner intends to maintain any rejection based on the assertion of Official Notice. Additionally, the Applicant respectfully requests the Examiner reconsider the assertion of Official Notice and provide to Applicant any basis for the Examiner's assertion of Official Notice. None of the cited references provide all of the teachings alleged as well known and necessary by the Examiner. The Applicant respectfully submits that these limitations establish a new way of game play, determination of success, and awarding of a prize. If the Examiner has any questions, the Examiner is invited and encouraged to contact the Applicant at the number below for further discussion.

Additionally, according to MPEP § 2112, an examiner must provide rationale or evidence tending to show inherency. The fact that a certain result may occur or be present in the prior art is not sufficient to establish inherency of that result. *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

The Examiner has not provided why it necessarily flows from the cited references that flashing composite symbol animation is necessarily determined as outlined in claims 1, 3-6, 8-9, and 11-25.

Thus, the Applicant respectfully traverses the Examiner’s assertions of Official Notice and/or inherency.

For at least these reasons, the Applicant respectfully submits that claims 1, 3-6, 8-9, and 11-25 should be allowable over the cited art of record.

Claims 4, 5, 11, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aristocrat Leisure Industries (WO 99/64997)(hereafter ALI) and

Suzuki (6,213,875) as applied to claims 1, 6-9, 12, 13, and 16-25 above, and further in view of Buxton et al. (6,118,427).

Applicant respectfully traverses the Examiner's rejection for at least the following reasons.

As discussed above, the combination of limitations recited in claims 1, 3-6, 8-9, and 11-25 is not disclosed by the combination of ALI and Suzuki. The graphical user interface of Buxton fails to disclose the limitations recited in the independent claims 1, 9, 16, 17, 18, 19, and 22, let alone their dependent claims 4, 5, 11, 14 and 15, for at least the same reasons discussed above. The graphical user interface of Buxton relates to a user merging images or layers of objects onto a graphical display. See, e.g., Abstract. Buxton fails to disclose flashing symbol animation and fails to teach or suggest other remaining limitations recited in claims 1, 9, 16, 17, 18, 19, and 22, let alone dependent claims 4, 5, 11, 14, and 15.

For at least these reasons, the Applicant respectfully submits that claims 4, 5, 11, 14, and 15 should be allowable over the cited art of record.

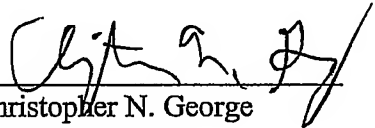
CONCLUSION

It is submitted that the present application is in condition for allowance and a Notice of Allowability is respectfully solicited. If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited and encouraged to contact the Applicant at the number below.

The Commissioner is authorized to charge any additional fees or credit overpayment to the Deposit Account of MHM, Account No. 13-0017.

Respectfully submitted,

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